

REMARKS

Claims 26, 29, 31-33, 35, 36, 39, 46-53, 55, 100, 101 and 103-106 remain in the application for prosecution. Claims 1-25, 27, 28, 30, 34, 37, 38, 40-45, 54, 56-99 and 102 have been cancelled. Claims 26, 35, 36, 46, 100 and 101 have been amended. Claims 103-106 have been added.

Claim Rejections – 35 U.S.C. §§ 102 and 103

Claims 26, 29, 31-36, 39, 94, 95, 97-99, 101 and 102 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,254,483 to Acres (“Acres”) or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Acres in view of IGWB New ’97 Games (“IGWB”).

Claim Rejections - 35 U.S.C. § 103

Claims 30, 46-53, 96 and 100 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Acres.

Claims 30, 46-53, 96 and 100 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Acres in view of IGWB.

Claims 37, 38, 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Acres in view of IGWB.

Claim 26

Claim 26 has been amended to include the limitations of claims 30, 34, 37 and 38. As such, claim 26 is now directed to the concept of the thematic art work on the video display changing to an entirely different theme – a holiday theme – having animated characters with indicia of the holiday theme. A few examples are provided in FIGS. 13-15.

As admitted in the Office Action, Acres does not disclose changing the themed artwork on the display to one that is associated with a holiday. Office Action, page 5. Acres simply teaches to change the background color. Column 2, line 63. Background color, however, does not constitute a theme by itself. Further, Acres does not teach when or why to change the background color.

In attempting to recast Acres' simple teaching on changing a background color, the Office Action states it would have been obvious to one of ordinary skill in the art to alter the gaming machine's background colors "(for example, brown/orange for Halloween and/or red/pink for Valentines' Day)." Office Action, pages 5 and 7. This position is unusual in that the Applicant has consistently argued that a variety of elements, when taken together, create a theme. Yet, while discrediting the Applicant's argument, the Office Action proves the Applicant's point by suggesting that a Halloween theme may be created by two background colors (brown and orange) and a Valentine's theme may be created by two background colors (red and pink). Again, Acres mentions nothing about mixing and matching colors. Nor does it suggest anything about creating holiday themes. It simply teaches changing a single background color.

Furthermore, claim 26 now calls for the holiday theme to include animated characters, a limitation that was previously presented in claims 37 and 38. Previously, pages 15-16 of IGWB were relied upon to reject those claims. Office Action, page 8. Yet, pages 15-16 of IGWB mention nothing about a video display presenting character animation. Rather, this passage discusses the idea of a group of adjacent gaming machines have a common theme, for example, locating a 3-D fireman and a 3-D Dalmatian above a group of gaming machines. Nowhere does this passage in IGWB discuss animated characters on the video display. Further, considering

that this passage in IGWB teaches the idea of creating a larger-than-life, grand theme on a group of adjacent gaming machines by using physical 3-D objects (*e.g.*, a fireman, a Dalmatian, etc.) attached to the gaming machines to create the theme, why would the skilled artisan read this passage and conclude it is acceptable to change the theme on the video display of the gaming machine? If that were done, then the physical objects above the gaming machines would be creating a different theme than the video display of the gaming machine.

In short, the references fail to disclose all of the elements of claim 26, nor can they be combined to render claim 26 obvious.

Claim 46

Claim 46 has been amended to include the limitations of claim 54. It requires that the modified game artwork includes player-selectable visual elements having indicia corresponding to the second theme and that the randomly selected outcome occurs in response to the player selecting at least one of the player-selectable visual elements. See FIGS. 13 and 14 for examples of such a configuration.

Acres simply teaches changing the card decoration corresponding to the casino's logo. There is absolutely no teaching in Acres of a game theme that is changed due to the occurrence of a commonly known societal event, much less a game theme where the player is selecting certain elements that have indicia associated with the newly changed game theme.

The Office Action cites to the Abstract and column 2, lines 46-52, of Acres and suggests that Acres teaches the automatic display of a modified game appearance that occurs with respect to a holiday. There is no such teaching in Acres. While Acres discloses changing a background color or a card decoration (to make it like a casino's logo), none of this occurs relative to a holiday. The only teaching in Acres regarding a holiday is that the pay table should be changed

in accordance with the demand on the casino floor, which is known to change during certain holidays. Simply mentioning that a pay table should change on certain holidays is not a teaching that the appearance of the game should also be altered on that same holiday. The Applicant appreciates that Acres provides a general teaching that multiple configuration parameters can be changed in response to multiple variables. Column 8, lines 63-65. But, such a generic teaching surely is not a teaching that, on a certain societal event, the appearance of the gaming machine should change (i) so that player-selectable visual elements are presented with indicia corresponding to that certain societal event, and (ii) the player-selectable visual elements are selected by the player during the operation of the gaming machine.

The Applicant also notes that in making the rejection of claim 46, the Office Action takes Acres' simple teaching that the background color (singular) can change and enhances it into a teaching that the background color can change to several colors (plural) indicative of a certain societal event. That is neither a fair nor accurate assessment of Acres' teaching. The Applicant respectfully suggests that hindsight is being used to reject the pending claims.

Also, page 11 of IGWB was used to reject former claim 54. Yet, it does not disclose player-selectable elements whatsoever. More importantly, it does not disclose player-selectable elements that have been changed to a new theme, one that is indicative of a societal event. The "sevens, cherries, and cabooses" may be symbols that indicate an outcome, but there is no teaching that a player selects these symbols while playing the game. In fact, page 11 simply teaches that gaming-machine manufacturers unveil new gaming machines each year and does not suggest anything at all about a gaming machine having the ability to alter its symbols at a predetermined time while the game is in operation. In short, this reference is not useful for rejecting amended claim 46.

Claim 100

Claim 100 has been amended to include one type of modification to the symbols. Specifically, the symbols do not entirely change. Rather, the modified symbols are the same as the standard symbols, but have indicia indicative of a commonly known societal event so as to have a second theme different from the first theme. Several examples can be seen by comparing FIGS. 7 and 13 (*e.g.*, items 92, 94 and 96 in FIG. 13).

In addition to the reasons set forth above regarding Acres' and IGWB's failure to teach modifying game symbols to be indicative of a commonly known societal event, neither of these references teaches adding indicia to the standard symbols to provide a different theme to the game being played at the gaming machine.

Claim 101

Claim 101 has been amended to require it to be a standard slot machine with video reels where the symbols on the reels are altered from a first set of symbols to a second set of symbols. The second set of symbols are indicative of a commonly known societal event. One example can be seen by comparing FIGS. 1 and 12.

In addition to the reasons set forth above regarding Acres' and IGWB's failure to teach modifying game symbols to be indicative of a commonly known societal event, neither of these references teach that the symbols on the video reels should be altered at a predetermined time corresponding to a commonly known societal event.

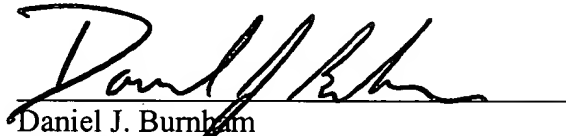
Conclusion

It is the Applicant's belief that the claims are now in condition for allowance, and action towards that end is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview,
the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

Date: April 6, 2004

A handwritten signature in black ink, appearing to read "Daniel J. Burnham", written over a horizontal line.

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